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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/662,263  | 09/15/2003  | Patrick H. Hayes     | 81230.38US4         | 9025             |
| 34018   | 7590        | 04/01/2005           | EXAMINER            |                  |
| GREENBERG TRAUIG, LLP<br>77 WEST WACKER DRIVE<br>SUITE 2500<br>CHICAGO, IL 60601-1732 |             |                      | ZIMMERMAN, BRIAN A  |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2635                |                  |

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/662,263

Applicant(s)

HAYES ET AL.

Examiner

Brian A Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pariente (WO 9409570) and Renner (5679945).

Pariente teaches a remote controller 1 that includes a readable media storage device 11 (chip-card) on which a microcircuit 12 is contained. Parameter codes defining or describing different electronic devices (the codes being stored on the chip card in memory which is inherently non-volatile) are read by the remote controller under the control of the microprocessor 15, internal to the remote controller 1, thereby programming the remote controller (abstract). Card 11 is inserted into slot 10. The card is removable and inherently includes

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electrical contacts in order for the remote controller to accept electrically transferable codes or commands.

The card programs the remote controller 1. The remote controller 1 accordingly now stores the codes/commands, the card is removed and the remote controller accesses internal memory EEPROM 18 to retrieve the codes/commands for operating a first (and subsequent different) electronic equipment.

In an analogous art, Renner teaches an intelligent card reader. In order to prevent unauthorized use of the smart card the card is programmed with limitations such as the number of times the card can be used or having a preprogrammed expiration date. See col. 11 lines 30-35. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an operation limitation to the number of times the Parienti card can be used in order to prevent unauthorized use of the card as suggested by Renner.

2. Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pariente (WO 9409570) and Ishikawa (5315392).

Pariente is discussed above, such discussion is incorporated here also. In an analogous art, Ishikawa teaches a remote control for a television. Ishikawa teaches a direct channel access button for accessing a specific channel in a line-up. This provides added convenience to the user/operator. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to

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have used a direct channel access button in the Pariente remote controller since such would provides added convenience to the user/operator.

3. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pariente (WO 9409570) and Krisbergh (5138649).

Pariente is discussed above, such discussion is incorporated here also. In an analogous art, Krisbergh teaches a remote control device. With regards to figure 2 Krisbergh states:

the remote control/telephone unit 10 is easily used for ordering pay-per-view services from the cable system.....In one embodiment, converter/descrambler 40 is preauthorized with a certain number of credits for receiving pay-per-view programs. If a subscriber's credit limit has not been depleted, the pay-per-view program will be immediately available for viewing. Microprocessor 48 will subsequently pass data to the cable system operator for billing purposes using data path 58 and telephone base station 42 to initiate a call to the headend for reporting of the information. In another embodiment, a telephone communication with the headend is established by microprocessor 48 via telephone base station 42 to request pay-per-view authorization upon receipt of a pay-per-view ordering signal from the remote control/telephone unit 10.

Therefore, Krisbergh teaches the use of the remote controller 10 for authorization of credit information to provide easy access to pay-per-view programs.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included credit information on the Pariente remote controller as suggested by Krisbergh since such would provide easy access to pay-per-view programs.

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4. Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Pariente (WO 9409570) and Ishikawa (5315392) as applied to claims 11 and 14 above, and further in view of Krisbergh (5138649).

The limitations of claim 17 mirror the limitations of claim 18 and are rejected using the same explanation of the references offered above.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3-11 of U.S. Patent No. 6657679 in view of Renner (5679945), Ishikawa (5315392) and Krisbergh (5138649). The differences between the pending claims and the claims of the '679 Patent are the same limitations the are discussed above as

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being obvious in a card programmed remote controller in view of the Renner, Ishikawa and Krisbergh references.

The claims correspond in the following manner.

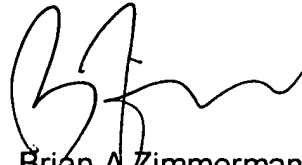
| Pending Application | Patent 6657679 |
|---------------------|----------------|
| 1,11,15,17,18,19    | 1              |
| 2                   | 3              |
| 3,14                | 4              |
| 4                   | 5              |
| 5,16                | 6              |
| 6                   | 7              |
| 7                   | 8              |
| 8                   | 9              |
| 9,12                | 10             |
| 10,13               | 11             |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 571-272-3059. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 571-272-3068. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'BA Zimmerman', with a stylized flourish at the end.

Brian A. Zimmerman  
Primary Examiner  
Art Unit 2635

BAZ